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09/863,882	05/23/2001	Takaaki Amano	100809-16256(SCET 18.691)	9462

7590 06/18/2007  
KATTEN MUCHIN ZAVIS ROSENMAN  
575 MADISON AVENUE  
NEW YORK,, NY 10022-2585

EXAMINER
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LASTRA, DANIEL

ART UNIT	PAPER NUMBER
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3622

MAIL DATE	DELIVERY MODE
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06/18/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/863,882

**Applicant(s)**

AMANO ET AL.

**Examiner**

DANIEL LASTRA

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9 and 10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

1. Claims 1-6, 9 and 10 have been examined. Application 09/863,882 has a filing date 05/23/2001 and foreign information 05/24/2000.

***Response to Amendment***

2. In response to Non Final Rejection filed 01/30/2007, the Applicant filed an Amendment on 04/02/2007, which amended claims 1, 3, 4, 6 and 10.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3, 4, 6 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Said claims recite "wherein the larger the total number of points accumulated by the person becomes, the smaller the point number displayed becomes stepwise". Said limitation is indefinite because Applicant's specification (see page 35, lines 15-25) is not clear about the meaning "stepwise". For purpose of art rejection, said limitation would be interpreted as limiting the amount of incentive points awarded to a particular person.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

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Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3, 4 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (US 5,855,008) in view of Gardenswartz (US 6,055,573) and further in view of Bachman (US 6,895,386).

As per claim 1, Goldhaber teaches:

A server apparatus for applying one or more incentive points by which a service can be received in response to an amount of said points to be used in a Web site, comprising:

network means for connecting a first apparatus and a second apparatus, said first apparatus being related to a person who shares cost required to provide the service (see column 8, lines 59-62), and said second apparatus being related to a person who applies said points (i.e., advertiser; see column 8, lines 59-62; column 10, lines 39-67);

applicable point number storage means for calculating an applicable point number based upon a point number responding to the cost shared by the person related to the first apparatus which is notified from said first apparatus, and also *based upon* an applied point number, and for storing there into the calculated applicable point number (see column 10, lines 39-67);

advertisement storage means for storing there into information used to display an advertisement with respect to the person concerning said first apparatus (see column 10, lines 39-67);

display point determining means for determining a point number to be displayed on said advertisement within said applicable point number in accordance with a predetermined rule (see column 10, lines 40-67);

web server means for producing a web page which displays said advertisement with respect to the person concerning said first apparatus, to which the determined point number has been applied under a selectable condition, and for displaying the produced web page on said second apparatus (see column 5, line 57 – column 6, line 7); and

applied point managing means for storing there into said displayed point number applied to said advertisement and an identifier for said second apparatus in relation to each other when the selection of said advertisement is accepted from said second apparatus (see column 10, lines 40-67; column 11, lines 32-45).

Goldhaber fails to teach that said predetermined rule includes decreasing said point number as a total number of points, accumulated by the person for said advertisement increases, *wherein the larger the total number of points accumulated by the person becomes, the smaller the point number to be displayed becomes stepwise*. However, Gardenswartz teaches a system that targets advertisements to consumers as a form of a value contract, in which a consumer is offered a reward (*i.e.* points) for interacting with an advertisement (see col 20, lines 45-50) and where said reward (*i.e.* points) is decreased based upon previous interaction of said consumer with said advertisement (see Gardenswartz col 17, lines 20-45; col 18, lines 1-5). Bachman teaches the necessity of capping customer's incentive points to limit how many incentive points a single customer may earn in a period because incentive points cost

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money and the companies, which are responsible for paying the bill when customers redeem their incentive points, have a limited budget (see Bachman col 9, line 65 – col 10, line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Goldhaber would decrease the reward (*i.e.* points) given to a user that had previously adequately interact with an advertisement and would increase said reward to users that have not adequately interacted with said advertisement, as taught by Gardenswartz in order to encourage said user to continue to engage in desirable behavior and/or to change undesirable behavior. An Advertiser using the Goldhaber's system would be motivated to decrease the amount of compensation pay to users (*i.e.* view-op) that has already interacted with an advertiser's ad in view that said advertiser would have an advertisement's budget limit with limited resources, where said budget limit would cap the total incentive points given to a user, as taught by Bachman and where said limited resources would be better put to use by offering bigger rewards to users that have never interacted or seen an advertiser's ad and offering lower rewards to users that had already interacted with said ad, therefore, limiting the total incentive points awarded to a user.

As per claim 3, Goldhaber teaches:

A program product capable of operating a computer as such a server apparatus for applying one or more incentive points by which a service-can be received in response to an amount of said points to be used in a web site, wherein said program product causes the computer to execute:

a network process for connecting a first apparatus and a second apparatus, said first apparatus being related to a person who shares cost required to provide the service (see Goldhaber column 8, lines 57-61), and said second apparatus being related to a person who applies said points (see Goldhaber column 8, lines 57-61; "advertiser"; see column 10, lines 40-67);

an applicable point number storage process for calculating an applicable point number based upon a point number responding to the cost shared by the person related to the first apparatus, and also an applied point number which is notified from said first apparatus, and for storing there into the calculated applicable point numbers an advertisement storage process for storing there into information used to display an advertisement related to the person concerning said first apparatus (see column 10, lines 40-67; column 11, lines 25-45);

a display point determining process for determining a point number to be displayed on said advertisement within said applicable point number in accordance with a predetermined rule (see column 10, lines 40-67);

a web server process for producing a web page which displays the advertisement related to the person concerning said first apparatus, to which the determined point number has been applied under selectable condition, and for displaying the produced Web page on said second apparatus (see column 5, line 42 – column 6, line 8); and

an applied point managing process for storing there into said displayed point number applied to said advertisement and an identifier for said second apparatus in

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relation to each other when the selection of said advertisement is accepted from said second apparatus (see column 11, lines 25-45). Goldhaber fails to teach that said predetermined rule includes decreasing said point number as a total number of points, accumulated by the person for said advertisement increases, *wherein the larger the total number of points accumulated by the person becomes, the smaller the point number to be displayed becomes stepwise*. However, the same argument made in claim 1 is made in claim 3 regarding said missing limitation.

As per claim 4, Goldhaber teaches:

A method for applying to an advertisement viewer, one or more incentive points by which a service can be received in response to an amount of said points to be used in a Web site, comprising:

a step in which as to cost which is notified via a network from an advertisement provider who snares cost required to provide a service, an applicable point number is calculated based upon both a point number in response to the cost shared by the advertisement provider and also a point number which has been applied to the advertisement viewer, and then, the calculated applicable point number is stored in an applicable point number storage means (see column 10, lines 40-67; column 11, lines 9-45):

a step in which a point number to be displayed on the advertisement of said advertisement provider is determined within the applicable point number in accordance with a point applicable rule which has been previously stored in the storage means (see column 10, lines 40-67);



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a step in which a web page which displays the advertisement of said advertisement provider, to which the determined point number is applied, under selectable condition to the advertisement viewer, is produced and then, the produced web page is transmitted to a terminal of the advertisement provider (see column 10, lines 40-67; column 5, line 40 – column 6, line 8) and

a step in which when said advertisement is selected by the terminal of said advertisement provider, both the point number applied to said advertisement and the advertisement viewer are stored into a storage means in relation to each other (see column 10, lines 40-67; column 11, lines 25-45). Goldhaber fails to teach that said predetermined rule includes decreasing said point number as a total number of points, accumulated by the advertisement viewer for said advertisement increases, *wherein the larger the total number of points accumulated by the person becomes, the smaller the point number to be displayed becomes stepwise*. However, the same argument made in claim 1 is made in claim 4 regarding said missing limitation.

As per claim 6, Goldhaber teaches:

A service providing method for providing a service to a customer responsive to one or more incentive points applied by the customer when an order by the customer is accepted in on-line shopping for accepting an order via a network, wherein:

a cost sharing person who shares cost as to said service corresponds to a person who invests his money in a sales person who sells goods in the on-line shopping (see column 8, lines 59-62; column 10, lines 40-67); and

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said cost sharing person is separated from the sales person (see column 10, lines 40-67; column 8, lines 59-62; advertisers and service providers);

wherein the sales person executes a process operation causing an advertisement with respect to the cost sharing person to be presented under a selectable condition to the customer prior to the acceptance of the order by the customer (see column 10, lines 40-67; column 11, lines 7-45); and

a point application to a customer is carried out by accepting the selection of the advertisement with respect to said cost sharing person, which is presented under said selectable condition (see column 10, lines 40-67; column 11, lines 7-45). Goldhaber fails to teach that said predetermined rule includes decreasing said point number as a total number of points, accumulated by the customer for said advertisement increases, *wherein the larger the total number of points accumulated by the person becomes, the smaller the point number to be displayed becomes stepwise*. However, the same argument made in claim 1 is made in claim 6 regarding said missing limitation.

5. Claims 2, 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (US 5,855,008) in view of Gardenswartz (US 6,055,573) and further in view of Ikeda (US 5,937,391) and Bachman (US 6,895,386).

As per claim 2, Goldhaber teaches:

The server apparatus as claimed in claim 1, but fails to teach wherein said server apparatus further comprises: online shopping means and said service responding to the amount of said points to be used corresponds to a discount service of purchased goods in the online shopping. However, Ikeda teaches a point-service system, where users

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redeem earned points by receiving discounts on products bought in an online shopping mall (see Ikeda column 2, lines 29-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would compensate users with credits or coupons (i.e. points), for viewing particular advertisements, as taught by Goldhaber (see Goldhaber column 11, lines 25-32) and said users would redeem said earned points by purchasing certain products offered in an online shopping mall, as taught by Ikeda. This feature would serve as a users' incentives to view certain advertisements, as said users would receive discounts on products for said viewing.

As per claim 5, Goldhaber teaches:

The point applying method as claimed in claim 4 wherein said point applying method is further comprises but fails to teach:

a step for accepting a purchase proposal of goods via a network and said service responding to the amount of said points to be used corresponds to a discount service of goods purchased in on-line shopping. However, Ikeda teaches a point-service system, where users redeem earned points by receiving discounts on products bought in an online shopping mall (see Ikeda column 2, lines 29-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would compensate users with credits or coupons (i.e. points), for viewing particular advertisements, as taught by Goldhaber (see Goldhaber column 11, lines 25-32) and said users would redeem said earned points by purchasing certain products offered in an online shopping mall, as taught by Ikeda. This feature would

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serve as a users' incentives to view certain advertisements, as said users would receive discounts on products for said viewing.

As per claim 9, Goldhaber teaches:

The service providing method as claimed in claims 6 but fails to teach wherein the service responding to the amount of said points is to discount a purchase price of goods ordered through the on-line shopping. However, Ikeda teaches a point-service system, where users redeem earned points by receiving discounts on products bought in an online shopping mall (see Ikeda column 2, lines 29-67). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that advertisers would compensate users with credits or coupons (i.e. points), for viewing particular advertisements, as taught by Goldhaber (see Goldhaber column 11, lines 25-32) and said users would redeem said earned points by purchasing certain products offered in an online shopping mall, as taught by Ikeda. This feature would serve as a users' incentives to view certain advertisements, as said users would receive discounts on products for said viewing.

6. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldhaber (US 5,855,008) in view of Gardenswartz (US 6,055,573) and further in view of Bachman (US 6,895,386) and Tomita (US 6,965,869).

As per claim 10, Goldhaber teaches:

A server comprising:

a web page display arrangement for producing a web page which displays an advertisement including a point number based on a predetermined rule (see figure 11);

an applied point manager for storing an identifier for a user who selects the advertisement (see column 11, lines 25-32).

Goldhaber fails to teach and *a stored point total associated with the user, the applied point manager adding the point number included in the advertisement selected by the user to the stored point total, the applied point manager applying the stored point total as a discount between the user and a retailer; and*

*a network arrangement adapted to communicate with a user and to allocate a cost of the discount from the retailer to an advertiser the advertiser being associated with the advertisement and the applied manager applying the stored point total as a discount between the user and a retailer and wherein the predetermined rule includes decreasing the point number each time the user or another selects the advertisement, wherein the larger the total number of points accumulated by the person becomes, the smaller the point number to be displayed becomes stepwise.* However, Gardenswartz teaches a system that targets advertisements to consumers as a form of a value contract, in which a consumer is offered a reward (*i.e.* points) for interacting with an advertisement (see col 20, lines 45-50) and where said reward (*i.e.* points) is decreased based upon previous interaction of said consumer with said advertisement (see Gardenswartz col 17, lines 20-45; col 18, lines 1-5). Tomita teaches an incentive point system that calculates the customer's total accumulated points in order to apply a discount to said customer using said total points (see Tomita col 2, lines 30-40) and Bachman teaches the necessity of capping customer's incentive points to limit how many incentive points a single customer may earn in a period because incentive points

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cost money and the companies responsible for paying the bill when customer redeems their earned incentive points have a limited budget (see Bachman col 9, line 65 – col 10, line 10). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Goldhaber would decrease the reward (*i.e.* points) given to a user that had previously adequately interact with an advertisement and would increase said reward to users that have not adequately interacted with said advertisement, as taught by Gardenswartz in order to encourage said user to continue to engage in desirable behavior and/or to change undesirable behavior. An Advertiser using the Goldhaber's system would be motivated to decrease the amount of compensation pay to users (*i.e.* view-op) that has already interacted with an advertiser's ad in view that said advertiser would have an advertisement's budget limit with limited resources, where said budget limit would cap the total incentive points given to a user, as taught by Bachman and Tomita and where said limited resources would be better put to use by offering bigger rewards to users that have never interacted or seen an advertiser's ad and offer lower rewards to users that had already interacted with said ad, therefore, limiting the total incentive points awarded to a user.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1-6, 9 and 10 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

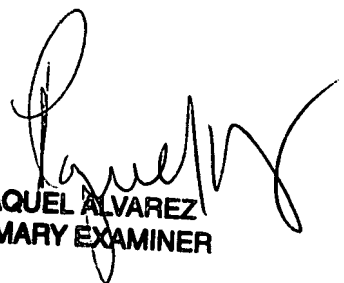
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Daniel Lastra  
June 3, 2007



RAQUEL ALVAREZ  
PRIMARY EXAMINER